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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER				
ZHAO, DAQUAN				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/607,338

Applicant(s)

NISHIZAWA, SHIN

Examiner

DAQUAN ZHAO

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI.08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 8/2/2010 have been fully considered but they are not persuasive.
2. Applicant invoke 35 U.S.C. 103(c) (1) to disqualify prior art Honda, US 2002/011517, under one or more of subsections (e), (f) and (g) of section 102. The examiner disagrees.
3. Prior art Honda was published on Dec, 19, 2002, which is prior to the filing date, 6/23/2003, of the instant application, and subsection (a) of 35 U.S.C 102 can be applied. 35 U.S.C 103(c) (1) can not be effected at this time since the foreign priority has not yet been perfected. To perfect the foreign priority, an English translation and a statement to certify the English translation is correct are needed.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-9, 13 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Onodera et al (US 7,331,055 B2), in view of Honda et al (US 200/0,191517 A1), and further in view of Maruyama et al (US 6,560,407 B2).

For claim 15, Onodera et al teach

urging a user to determine the record information to be recorded on the optical disc and the image to be formed on the optical disc (e.g. column 6, lines 20-67, user has to determine what information should be recorded on the disc and the user has to determine what label image should be printed on the disc);

determining both an area of the optical disc at which the record information is to be recorded by the optical disc recording apparatus and an area at which the image corresponding to the image information is to be formed by the optical disc recording apparatus before recording the record information and forming the image (e.g. column 6, lines 20-67, and figures 7-8 user can determine an area for normal writing and area for label printing. For example, see figure 8, user can write "program data" to the "1a:PROGRAM AREA" as shown on figure 8 and write the label on "1b:LABEL AREA", wherein these two areas are on the same side of the disc, and both side of the disc are considered to be the recording face because side a and side b both can store data); and

displaying on the display optical disc information (e.g. column 12, lines 32-45, figures 13a and 13b).

recording the determined record information on the optical disc and forming the determined image on the optical disc after the displaying step, wherein the determined record information is recorded on the recording face of the optical disc and the determined image is formed on the recording face of the optical disc by applying a laser

beam (e.g. column 9, lines 55-63, pickup 38 and "semiconductor laser" writes data on the recording layer of the disc).

Column 6, lines 40-49, and figure 7(b) teach a ring shaped label area 2b and a program area 2a provided on the inside of the label area 2b in a radial direction. However, Onodera et al fail to specify automatically in succession thereafter (after data is writing on the program area) the determined image (label) is formed. Honda et al teach automatically in succession thereafter the determined image is formed (e.g. paragraph 47, "This printing operation is repeated to print so that the optical pickup 66 is sequentially moved toward the outer circumference at the predetermined pitch ..."). one ordinary skill in the art at the time of the invention was made would have been motivated to apply the label printing method of Honda et al to write and print data sequentially toward the outer circumference from the inner circumference to record data according to the layout of Onodera et al because Onodera et al teach the program data area is inside the label area in a radial direction to improve the data writing and label print speed of the system since the optical head does not have to jump back and forth.

However, Onodera et al and Honda et al fail to teach information reflecting the record information and the label image. Maruyama et al teach information reflecting the record information and the label image (e.g. column 30, lines 16-35). It would have been obvious to one ordinary skill in the art at the time the invention was made to incorporate the teaching of Maruyama et al into the teaching of Onodera et al and Honda et al to preview the label image to allow user to conveniently preview the size and position of the label image in advance (e.g. Onodera et al, column 12, lines 42-45).

Claim 16 is rejected for the same reasons as discussed in claim 15 above,

Claim 1 is rejected for the same reasons as discussed in claim 16 above, wherein Maruyama et al teach giving instructions for starting recoding of the record information and instructions for starting formation of the image corresponding to the image information to the optical disc recording apparatus after the displaying step (e.g. column 31, lines 11-20, "if the digital information recording/playback system receives designation of a print target via the operation panel **after** the print menu frame is displayed on output device 46a (YES in ST3), it **instructs** the printer to print the designated print target").

Claim 3 is rejected for the same reasons as discussed in claim 16 above.

Claim 6 is rejected for the same reasons as discussed in claim 1 above.

Regarding claim 5, Maruyama et al teach a step of urging the user to determine whether the recording and forming step is to be executed based on the optical disc information (e.g. user gives instruction by pressing key 5pri of the remote controller 5 in step ST1 of figure 21, also see figure 20).

Regarding claim 7, Maruyama et al teach a notifying function of requesting an input of setting information which is necessary for determining the recording operation and the image forming operation by the optical recording apparatus (e.g. figure 21, step ST2 shows the display print menu frame to notifying user what the printing data on the disc would be), and

wherein the operation determining step includes a step of determining the operation of recording the record information (e.g. user presses the "record button" on

the remote controller) and determining the operation of forming the image in accordance with the input setting information before the instructing step (e.g. user presses the print button after the print menu frame is displayed).

Regarding claim 8, Maruyama et al teach a first obtaining step of obtaining an information amount of designated record information and an information amount of designated image information, and a notifying function of notifying the information amounts of the information which are obtained by the first obtaining function, and wherein setting information includes at least record file information for designating record information and image file information for designating image information (e.g. column 31, lines 28-45, and figure 23c, the amount used for storing the image is considered to be the "an information amount of designated record information and an information amount of designated image information", wherein "an information amount of designated image information" is considered not differ from "an information amount of designated record information" because the image is recorded).

Regarding claim 9, Maruyama et al teach the program further causes the computer to execute: a first obtaining step of obtaining an information amount of designated record information and an information amount of designated image information; a second obtaining step of obtaining a free area of the optical disc; and a notifying step of comparing a total of the information amounts of the information which are obtained in the first obtaining step with the free area which is obtained in the second obtaining step, and, when the total of the information amounts is larger than the free area, notifying that the total of the information amounts is larger than the free area, and

wherein the setting information includes at least record file information for designating record information and image file information for designating image information (e.g. column 31, lines 28-45, and figure 23, user visually compares the used and unused amount in contract with each other. the amount used for storing the image is considered to be the "an information amount of designated record information and an information amount of designated image information", wherein "an information amount of designated image information" is considered not differ from "an information amount of designated record information" because the image is recorded).

Regarding claim 2, Maruyama et al teach the operation of recording the record information is determined after the operation of forming the image is determined (e.g. user can determine press either the "record" button or the "print" first and then the other one next).

For claims 17-18, Onodera et al teach the area which the image is to be formed is located radially outward and adjacent to the area at which the record information is recorded (e.g. see figure 8, user can write "program data" to the "1a:PROGRAM AREA" as shown on figure 8 and write the label on "1b:LABEL AREA", Areas 1a and 1b has to be radially outward because they are located in a disc, also see figures 7a-7b).

For claim 13, Onodera et al, Honda et al and Maruyama et al fail to teach a pattern of an image formation. Honda et al teach writing different pattern of image on the surface of the disk (e.g. see figure 12A-C).

5. Claims 10, 11, 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Onodera et al (US 7,331,055 B2), Honda et al (US 2002/0,191,517) and Maruyama et al (US 6,560,407 B2), as applied to claims 1-3, 5-9, 13 and 15-18 above and further in view of Official Notice.

See the teaching of Onodera et al, Honda et al and Maruyama et al above.

For claims 10 and 12, Onodera et al, Honda et al and Maruyama et al fail to teach editing the information. It is noted that editing the information is well known in the art. The examiner takes official notice for it. It would have been obvious for one ordinary skill in the art at the time the invention was made to edit the information in accordance with a result of comparison between the information amounts of the information obtained in the first obtaining step, and the free area obtained in the second obtaining step to avoid recording error due to insufficient storage space.

For claim 11, Maruyama et al teach the total of the information amounts of the information is larger than the free area as a result of the comparison between the information amounts of the information obtained in the first obtaining step and the free area obtained in the second obtaining function (e.g. column 31, lines 29-45, and figure 22 A-C, user visually compare the used and unused storage amount).

For claim 14, Onodera et al, Honda et al and Maruyama et al fail to teach a pattern of an image formation. Honda et al teach writing different pattern of image on the surface of the disk (e.g. see figure 12A-C).

There's no new ground(s) of rejection. Accordingly, THIS ACTION IS MADE FINAL. See MPEG § 706.07 (a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136 (a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing data of this action. In the event a first reply is filed within TWO MONTHS of the mailing data of this action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period. Then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing data of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the data of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daquan Zhao whose telephone number is (571) 270-1119. The examiner can normally be reached on M-Fri. 7:30 -5, alt Fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tran Thai Q, can be reached on (571)272-7382. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Daquan Zhao/

Examiner, Art Unit 2621

/Thai Tran/

Supervisory Patent Examiner, Art Unit 2621